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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,459	07/01/2003	Keith Robert Hildebrand	11738.00161	1626
22908	7590	02/10/2005	EXAMINER	
BANNER & WITCOFF, LTD. TEN SOUTH WACKER DRIVE SUITE 3000 CHICAGO, IL 60606			KENNEDY, SHARON E	
			ART UNIT	PAPER NUMBER
			3762	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/611,459

Applicant(s)

HILDEBRAND, KEITH ROBERT

Examiner

Sharon Kennedy

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date all.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action or the MPEP.

Double Patenting

Claims 1-55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6,656,172. Although the conflicting claims are not identical, they are not patentably distinct from each other because each of the claims is directed to the method of treating tinnitus by inserting a catheter into the patient's cerebrospinal fluid and administering a drug formulation.

It is becoming common to delay filing the terminal disclaimer(s) until all the claims are indicated as allowable. However, this places a burden on the examiner and the USPTO to conduct additional paper processing, docketing, and examination. Accordingly, applicant must file the terminal disclaimer(s) in response to this office action or supply substantive arguments against the double patenting rejection(s).

Claim Objections

Claim 56 is objected to because of the following informalities: The word "formations" should be changed to --formulations--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

Claim 56, 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Elsberry et al., US 5,711,316. Elsberry discloses a catheter adapted to be implanted into the cerebrospinal fluid in combination with a drug formulation such as baclofen. See column 2, line 21. Although Elsberry is for the treatment of neurodegenerative diseases, for example Parkinson's disease, the intended use of the system as recited in the preamble is not accorded much patentable weight.

Claims 56 and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaneko, February 2000. Kaneko discloses intrathecally-administered gabapentin to inhibit formalin-evoked nociception. Although Kaneko is not for the treatment of tinnitus, the intended use of the system as recited in the preamble is not accorded much patentable weight.

Claim Rejections - 35 USC § 103

Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elsberry '316. Elsberry discloses the system including drug formulations comprising GABA agonists. Elsberry does not specifically disclose gabapentin. Since gabapentin is a well-known GABA agonist, it would be prima facie obvious to one of ordinary skill in the art to use gabapentin with the Elsberry system since Elsberry specifically discloses the GABA agonist.

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Allowable Subject Matter

Claims 1-55 would be allowed if a terminal disclaimer as required above were filed.

The following is a statement of reasons for the indication of allowable subject matter: These claims mirror the claims allowed in the parent application, and allowed for the reasons set forth therein.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon Kennedy whose telephone number is 571/272-4948. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571/272-4955.

Information regarding the status of an application may be obtained by going to www.uspto.gov, clicking on "Status &IFW", entering the application number, and then clicking on one of the tabs to retrieve the appropriate information.



Sharon Kennedy
Primary Examiner
Art Unit 3762

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